

Appl No. 09/618,235
Amdt. Dated 8/09/2004
Reply to Office Action of 06/09/2004
Customer No. 27752

Remarks

Claims 1-21 are pending in the present application. No additional claims fee is due.

The Rejection under 35 U.S.C. 112, second paragraph

Claims 1-21 have been rejected under 35 U.S.C. 112, second paragraph as being indefinite. Applicants respectfully traverse this rejection, as the Office Action has not provided evidence of a prima facie case to support the rejection. In rejecting a claim under the second paragraph of 35 U.S.C. §112, it is incumbent upon the Examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and clarity the particular area set out and circumscribed by the claims. *Ex parte Wu*, 10 USPQ2d 2031, 2033 (B.P.A.I. 1989); *In re Hammack*, 427 F.2d 1378, 166 USPQ 204 (C.C.P.A. 1970). Thus, the Examiner has the burden of providing reasons why the terminology is indefinite or would not readily be understood by those of ordinary skill in the art.

Furthermore, MPEP 2173.02 states that "the examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available." MPEP 2173.02 also states that "some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire." Examiners should not reject claims or insist on their own preferences if other modes of expression selected by the applicants satisfy the statutory requirements.

The Office Action states that in Claim 2, "the final claim term, 'not nil', is a double negative, 'not nothing', because 'nil' means 'nothing' according to Webster's Ninth New Collegiate Dictionary (Merriam-Webster 1990)." Applicants agree that "nil" means "nothing" and therefore, "not nil" is a double negative meaning "not nothing." However, both the terms "nil" and "not nil" are ascertainable to one skilled in the art, as the Office Action has correctly interpreted the meaning of these terms through use of a common dictionary. Also, "linking moiety" is clearly described on pages 12-13 of the specification. Thus, one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would have been able to ascertain with a reasonable degree of precision and clarity the particular area set out and circumscribed by the claims.

Furthermore, Claims 2, 14, 15, and 19 recite "polypeptide" and "polymer." Pages 10-12 of the specification describe what is encompassed by polypeptide moieties and polymer moieties. As such, one of ordinary skill in the pertinent art, when reading the claims in light of the

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supporting specification, would have been able to ascertain with a reasonable degree of precision and clarity the particular area set out and circumscribed by the claims.

The Office Action has not properly established that the meaning of Claims 1-21 is not reasonably ascertainable to one of ordinary skill in the art in view of the specification. The Office Action has not explained why one skilled in the art, in view of the specification, would not understand what is meant by the claim language of Claims 1-21.

Applicants respectfully submit that Claims 1-21 is definite and that one of ordinary skill in the art would readily ascertain what is claimed. Accordingly, Applicants respectfully submit that the rejection under 35 U.S.C. 112, second paragraph should be withdrawn.

Conclusion

WHEREFORE, Applicants respectfully request reconsideration of this application and allowance of Claims 1-21.

Respectfully submitted,

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